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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,770	09/12/2003	Lawrence F. Glaser	740370-051	5779

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NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER	
CHOW, MING	
ART UNIT	**PAPER NUMBER**
2645	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/660,770	GLASER ET AL.	
	Examiner	Art Unit	
	Ming Chow	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Information Disclosure Statement

1. The information disclosure statement filed on 2-16-99 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Examiner has not received all references listed as foreign patent documents and non patent literature documents. The information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-10, 30, 32-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 43 of U.S. Patent No. 5875242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claim is broad and includes the limitation of claims 34 and 43 of U.S. Patent No. 5875242. For example, the patented claim 34 recites all the limitations of claim 1 and further including additional limitation for control means (see col. 35 line 66 to col. 36 line 24). Therefore, claim 1 is broader than the patented claim 34.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 6, 29, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Elrod et al (US-PAT-NO: 5,455,852). How the very broad terms of these claims read on the reference should be readily apparent from a reading of the abstract of the patent, which refers to the different types of IPU protocols, and the system's capabilities to accommodate them. Of course, in order to accommodate the different protocols, it is inherent that the system must have a database of configuration data for the purpose.

4. Claims 11, 12, 17-24, 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Krauss et al (US-PAT-NO: 5,369,696). In the patent, see column 2 line 41 to column 3 line 2, and column 5 line 55 to column 6 line 40. Note also Fig. 3, which clearly is characterizable as a "maintenance computer system". In Krauss, the (analog) "LU" is the "installed telecommunications device" and the "DCLU" is the "replacement telecommunications device" of applicant's subject claims. Again, the broad terms of the claims clearly are readable on the reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 3 above, and in view of O'Kelly (US: 5652787). Elrod et al failed to teach "at least one telecommunications device.....is transferred to said call accounting system". However, O'Kelly teaches on column 1 line 42-55 a network management system perform functions of accounting and others for PBX. It would have been obvious to one skilled at the time the invention was made to modify Elrod et al to have the "at least one telecommunications device.....is transferred to said call accounting system" as taught by O'Kelly such that the modified system of Elrod et al would be able to support the accounting system for PBX to the system users.

6. Claims 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 3 above, and in view of O'Kelly et al.

The modified system of Elrod et al in view of O'Kelly et al as stated in claim 7 above failed to teach "configuration data is one of a user name and an extension number". However, "Official Notice" is taken that configuring a PBX, or a call accounting system, or a voice messaging system by using either user name or an extension number is old and well known to one skilled in

the art. It would have been obvious to one skilled at the time the invention was made to modify Elrod et al in view of O'Kelly et al to have the "configuration data is one of a user name and an extension number" such that the modified system of Elrod et al in view of O'Kelly would be able to support the convenience of configuration by using user name or extension number to the system users

7. Claims 5, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 3 above, and in view of Morganstein et al (US: 5940476). Elrod et al failed to teach "at least one telecommunications device.....is transferred to said voice messaging system". However, Morganstein et al teach on column 2 line 56-63 a PBX system include voice messaging capability. It would have been obvious to one skilled at the time the invention was made to modify Elrod et al to have the "at least one telecommunications device.....is transferred to said voice messaging system" as taught by Morganstein et al such that the modified system of Elrod et al would be able to support the voice messaging system for PBX to the system users.

8. Claims 13-16, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krauss et al as applied to claim 11 above, and in view of Espeut et al (US-PAT-NO: 5,657,376). Krauss described a maintenance computer system that provides for reconfiguring parameters in the system to handle substitution of one type of line unit for another. Espeut et al describes a system of multiple voice message processors (101) that are controllable by a maintenance computer system (117), see therein column 7 line 28-46. Anyone of ordinary skill in this very well developed art would have recognized that the maintenance processor 117 of Espeut et al

could be used to provide for such parameter and data adjustments as would be needed if a VMS were to be replaced. Moreover, the average artisan also clearly would have recognized that such adjustment in fact constitute "configuration" adjustments. Inasmuch as Krauss et al described a maintenance computer system to oversee reconfigurations required for replacement of one type of telecommunications device with another one of the same genus but a different species, and Espeut et al described a maintenance computer system that controls a wide variety of administrative functions of the VMSs with which is associated, and replacement of any of those VMSs of course would be expected to be possible under normal operating conditions, it therefore clearly would have been obvious that Espeut et al suggested that the computer therein could have provided for such configuration adjustments as would be necessary in replacements of any VMSs therein. Note also that Espeut mentioned the also obvious aspect of "different manufactures": see therein column 6 line 16-19. It is considered obvious as well and by similar reasoning, that a call accounting system replacement could have been accommodated. As was well known in the art, call accounting systems are sometimes associated "adjuncts" or "modules" in much the same manner as the VMSs of Espeut et al, so their replacement would have been recognized as being similarly addressable.

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 1 above, and in view of Prager et al (US: 5838918). Elrod et al failed to teach "control means further functions.....in response to said change". However, Prager et al teach on column 2 line 66 to column 3 line 9 a configuration database is reread (the claimed "retrieve") once a change is made and the configuration management system effects the element's behavior.

It would have been obvious to one skilled at the time the invention was made to modify Elrod et al to have the "control means further functions.....in response to said change" as taught by Prager et al such that the modified system of Elrod et al would be able to support the detection of configuration data changes to the system users

10. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 3 above, and in view of Ruiz (US-PAT-NO: 5,416,781). Elrod et al failed to teach at least one telecommunications device consists of a PBX telephone switch. However, Ruiz teaches on column 12 line 50-53 "PBX". It would have been obvious to one skilled at the time the invention was made to modify Elrod et al to have the at least one telecommunications device consists of a PBX telephone switch as taught by Ruiz such that the modified system of Elrod et al would be able to support the PBX to the system users.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 3 above, and in view of Boatwright et al (US-PAT-NO: 5,291,547). Elrod et al failed to teach at least one telecommunications device consists of a call accounting system. However, Boatwright et al teach on Fig. 1 a PBX consists of a call accounting system. It would have been obvious to one skilled at the time the invention was made to modify Elrod et al to have the at least one telecommunications device consists of a call accounting system as taught by Boatwright et al such that the modified system of Elrod et al would be able to support the call accounting system to the system users.

12. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 3 above, and in view of Klein (US-PAT-NO: 5,646,981). Elrod et al failed to teach at least one telecommunications device consists of a voice messaging system. However, Klein teaches on Fig 1 a telecommunications device (10) consists of a voice messaging system (12). It would have been obvious to one skilled at the time the invention was made to modify Elrod et al to have the at least one telecommunications device consists of a voice messaging system as taught by Klein such that the modified system of Elrod et al would be able to support the voice messaging system to the system users.

13. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod et al as applied to claim 3 above, and in view of Ayoub et al (US-PAT-NO: 6,295,491). Elrod et al failed to teach control means further operates to synchronize the configuration data stored within the computer database of the apparatus with the configuration data stored in said at least one telecommunications device. However, Ayoub et al teach on column 2 line 23-50 how the database is synchronized for communication system operation control. It would have been obvious to one skilled at the time the invention was made to modify Elrod et al to have the control means further operates to synchronize the configuration data stored within the computer database of the apparatus with the configuration data stored in said at least one telecommunications device as taught by Ayoub et al such that the modified system of Elrod et al would be able to support the synchronization of configuration data to the system users.

Conclusion

14. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Bernadis et al (US-PAT-NO: 4,782,517) teach system and method for defining and providing telephone network services.

15. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general mature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

Ming Chow

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600